

PHA 4199.1(3090/7/US)

REMARKS

This paper re-submits amendments that were presented after the final rejection of March 10, 2005, but not entered by the Examiner. See the Advisory action of May 25, 2005.

The courteous telephone interview initiated by the Examiner with Applicants' undersigned attorney on May 23, 2005 is respectfully acknowledged.

After entry of this amendment, claims 66, 68-69, 72-73, 75-76, 78-79, 82-83, 86, 94-97 and 99-101 will be pending. Claims 66, 69, 73, 75, 76, 78, 79, 82, 83, 86, 94-97 and 99-101 are amended and claim 98 is cancelled.

During the telephone interview, the Examiner stated the claims were not in allowable form because they violated the M.P.E.P. requirement that a process claim describe "how" the process is carried out. For example, with regard to those claims which require abstraction of a leaving group, Applicants' attorney understood the Examiner to state that such claims are not in proper form because they do not specify the reagent by which the abstraction is achieved. With regard to the epoxidation claims, the Examiner was understood to require that the reagents used in this conversion should also be recited.

Applicants' attorney offered explanation during the interview that the claims do in fact specify how the recited conversions are accomplished. He also asked the Examiner for a citation of the section of the M.P.E.P. in which the Examiner relies in finding the claims defective. Applicants note that the final Office action dated March 10, 2005 states "[t]he claims must recite the reagents, the reaction time, pH, and reaction conditions that are applicable in each step having support in the specification."¹ Applicants present arguments herein rebutting the Office's position. It is respectfully submitted that the specific reaction conditions are not required to be recited in the claims to satisfy the requirements of 35 U.S.C. § 112.

¹ Office action dated March 10, 2005, page 3.

PHA 4199.1(3090/7/US)

Consistent with the position presented on behalf of Applicants during the aforesaid telephone interview, it is respectfully submitted that, in reciting abstraction of the leaving group, the claims as pending specify "how" the intermediate having an 11 α -leaving group is converted to the corresponding 9,11-olefin; and that, in reciting oxidation, the claims as pending specify how the 9,11-olefin is converted to the 9,11-epoxy. The M.P.E.P. supports this position by stating

[C]laims are not rejected as broader than the enabling disclosure under 35 U.S.C. § 112 for noninclusion of limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious. One does not look to the claims but to the specification to find out how to practice the claimed invention.²

Further, the novelty and non-obviousness of the pending claims is based on the selection of the substrate. Thus, given the benefit of Applicant's disclosure regarding the selection of substrates, one skilled in the art would have known how to conduct the chemical transformations recited in accordance with well known alternatives. Accordingly, the amended claims satisfy the enablement requirement.

Reconsideration is therefore requested of the rejection of claims 66, 68-69, 72-73, 75-76, 78-79, 82-83, 86 and 94-101 under 35 U.S.C. § 112 for lack of written description support. It is respectfully submitted that amended claims 66, 69, 73, 75, 76, 78, 79, 82, 83, 86, 94-97 and 99-101 satisfy the written description requirement as they recite the chemical transformation occurring in each reaction step in terms expressly disclosed in the specification and/or original claims, thus demonstrating that Applicants were in possession of the invention. Because a person skilled in the art would know how to carry out the specific chemical transformations (e.g., epoxidize, eliminate a leaving group,

² See M.P.E.P. § 2164.08; *In re Skrivan*, 427 F.2d 801, 806, 166 U.S.P.Q. 85, 88 (C.C.P.A. 1970); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558, 220 U.S.P.Q. 303, 316-317 (C.C.P.A. 1976).

PHA 4199.1(3090/7/US)

esterify, hydrolyze, etc.) recited in the claims by reading the specification and from knowledge in the art, the § 112 enablement requirement is satisfied.

Claims 76, 94-97 and 99-100 use original claim language to describe the chemical transformations in each step of the synthesis. For original claims, "there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed."³ Accordingly, the Office has failed to rebut the presumption that claims 76, 94-97 and 99-100 have adequate written description in the specification.

Reconsideration is also respectfully requested of the rejection of claims 66, 68-69, 72-73, 75-76, 78-79, 82-83, 86 and 94-101 under 35 U.S.C. § 112 paragraph 2 as failing to comply with the definiteness requirement. Applicant respectfully submits that amended claims 66, 69, 73, 75, 76, 78, 79, 82, 83, 86, 94-97 and 99-101 are definite. For example, claim 66 is amended to require "epoxidizing" a compound of formula II to form a compound of formula I. A person of ordinary skill would understand what is meant by "epoxidizing" and would further understand which reactions qualify as "epoxidizing" and which do not. The same principle applies with respect to the other specific terms that have now been inserted in the claims in lieu of the term "converting." Moreover, from the specification combined with knowledge generally available to the art, those skilled in the art know the universe of reagents necessary to effect each of the chemical transformations now particularly specified in the claims. Accordingly, it is respectfully submitted that the amended claims are definite under 35 U.S.C. § 112 paragraph 2.

In addition, the claim amendments are supported in the specification, for example, claims 66, 94 and 101 are supported at paragraphs 276 and 289-290 of the specification. Support for amendments to claims 66, 95 and 101 can be found, for example, at paragraphs 260, 264 and 270 of the specification. Support for amendments to claims 69, 96 and 101 can be found, for example, at paragraph 249 of the specification. Support for amendments to claims 73, 97

³ See M.P.E.P. § 2163.03.

PHA 4199.1(3090/7/US)

and 101 can be found, for example, at paragraph 236 of the specification. Support for amendments to claims 76 and 101 can be found, for example, at paragraph 228 of the specification and in original claim 14. Support for amendments to claims 79, 99 and 101 can be found, for example, at paragraph 220 of the specification. Support for amendments to claims 83, 100 and 101 can be found, for example, at paragraph 178 of the specification.

Along with the amendments described above, the chemical structures of formulae VI and VII are corrected to conform to the specification in claims 73, 75, 76, 78, 82, 86 and 101.

The instant amendments have been made to meet the Examiner's grounds of rejection and expedite prosecution of this application. Applicants respectfully submit that the claims as previously pending also satisfy the statutory requirements of 35 U.S.C. §112, and further respectfully reserve the right to pursue these claims in a continuation or divisional application. However, in view of the instant amendments, the merits of these claims are no longer at issue in this application.

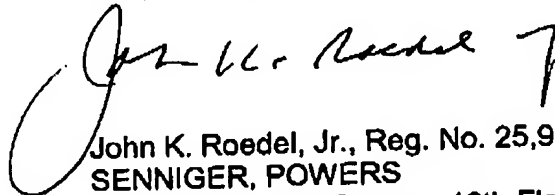
PHA 4199.1(3090/7/US)

CONCLUSION

Favorable consideration and early allowance of all pending claims are requested.

Applicants do not believe that a fee is due in connection with this response. If, however, the Commissioner determines that a fee is due, he is authorized to charge Deposit Account No. 19-1345.

Respectfully submitted,



John K. Roedel, Jr., Reg. No. 25,914
SENNIGER, POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

JKR/JSH/cwa